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| APPLICATION NO.           | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------|-------------|----------------------|---------------------|------------------|
| 10/561,185                | 03/01/2007  | Ross John Bartlett   | 403572/FISHER       | 1715             |
| 23548                     | 7590        | 07/10/2008           | EXAMINER            |                  |
| LEYDIG VOIT & MAYER, LTD  |             |                      | AHMAD, CHARISSA L   |                  |
| 700 THIRTEENTH ST. NW     |             |                      |                     |                  |
| SUITE 300                 |             |                      | ART UNIT            | PAPER NUMBER     |
| WASHINGTON, DC 20005-3960 |             |                      | 3635                |                  |
|                           |             |                      |                     |                  |
|                           |             |                      | MAIL DATE           | DELIVERY MODE    |
|                           |             |                      | 07/10/2008          | PAPER            |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/561,185             | BARTLETT ET AL.     |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Charissa Ahmad         | 3635                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 April 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-29 is/are pending in the application.  
 4a) Of the above claim(s) 13,17-19,21-23 and 25-29 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-12,14-16,20 and 24 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 16 December 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. **Claims 13, 17-19, 21-23, and 25-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.** Applicant timely traversed the restriction (election) requirement in the reply filed on 4/30/2008. Although, the Applicant indicated in the reply that claims 1-29 read on the elected species of Figures 1 and 2, Examiner respectfully disagrees. There is no welding indicted in the species of Figures 1 and 2. Additionally, there are no stiffening ribs. Therefore, these claims have been withdrawn as being drawn to a nonelected species.

2. **Applicant's election with traverse of Claims 1-12, 14-16, 20, and 24 in the reply filed on 4/30/2008 is acknowledged.** The traversal is on the ground(s) that claim 1 is a generic claim. This is not found persuasive because as Applicant has acknowledged in the specification on page 10, there are various embodiments of the invention present. These embodiments relate to the configuration of the beam as well as the means of forming the beam. If Applicant believes that only one embodiment is present, then applicant can state on the record that all embodiments are obvious variants on each other.

The requirement is still deemed proper and is therefore made FINAL.

### ***Information Disclosure Statement***

3. The references cited in the Search Report for international application no. PCT/AU2004/000824 dated July 22, 2004 will not be listed on any patent resulting from this

application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO/SB/08A and 08B form, must be filed within the set period for reply to this Office action.

4. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 1-12, 14-16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oliver et al. (UK Patent Application Publication 2261248 A).** Oliver et al. discloses a channel-shaped structural beam comprising: a planar elongate web (12) and hollow parallel sided flanges (13, 14) extending parallel to each other perpendicularly from a plane of said web along opposite sides thereof, said hollow flanges both extending in the same direction away from one face of said web, said beam having a ratio of the width of each said flange between opposite end faces thereof in a direction perpendicular to said plane of said web (Figure 1). Said beam is fabricated. Said beam can be fabricated from a single sheet of steel (Lines 25-27, page 10 and Lines 1-11, page 11).

With respect to the dimensions, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the beam of Oliver et al. having the width, thickness and depth dimensions disclosed in Claims 1-9, since the dimensions would have been a matter of design choice and the beam of Oliver et al. would operate equally well with any desired dimensions. No unexpected results are obtained from the claimed dimensional ratios and as such they are viewed as nothing other than obvious choice of design.

Additionally, Oliver et al. discloses the claimed invention except for fabricating the beam out of high strength steel and stainless steel. It would have been obvious to one having ordinary skill in the art at the time of the invention to fabricate the beam out of high strength steel, or stainless steel, since it has been held to be within the general skill of a worker in the art to select

a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re-Leshin*, 125 USPQ 416.

Finally, Claims 15, 16 and 20 disclose different processes for forming the beam. The court in *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) held that the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP 2113. In the instant case, the beam disclosed in Oliver et al. is the same as what is disclosed in the claims despite the fact that the beam of Oliver et al. may have been formed by a different process.

7. **Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oliver et al. (UK Patent Application Publication 2261248 A) in view of Becker et al. (US Patent 2,264,897).** Oliver et al. discloses the claimed invention as discussed above except it does not disclose a corrosion resistant coating. Becker et al. discloses sheet steel having a corrosion resistant coating (Lines 2-4, Column 1, Page 2). At the time of the invention, it would have been obvious to a person of ordinary skill in this art to provide a corrosion resistant coating disclosed in Oliver et al. in view of the teaching of Becker et al. The motivation for doing so would have been to weatherproof the beam.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charissa Ahmad whose telephone number is (571) 270-5220. The examiner can normally be reached on Monday - Friday 7:30 am to 5 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner  
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